

REMARKS

In response to the Office Action mailed July 24, 2009, Applicants respectfully request reconsideration. Each of the issues raised in the Office Action is addressed herein.

Applicant respectfully requests reconsideration of claims 1-3, 5-10 and 22-24 which were previously pending in this application. By this amendment no claims have been amended. However, new claims 25 and 26 have been added. As a result, claims 1-3, 5-10, 22-26 are pending for examination with claims 1, 22 and 25 being independent. No new matter has been added.

Rejections Under 35 U.S.C. §112

The Office Action rejects new claims 22-24 under 35 U.S.C. §112, first paragraph. The Office Action asserts that the application as filed provides no disclosure of “each SMS message comprising a portion of the text.” Applicants respectfully disagree.

The application as filed describes at [0004] that SMS is a messaging protocol for chat/instant messaging. In [0005], the application describes that “the invention enables two parties to conduct an on-line chat session on mobile phones.” One of skill in the art would have understood the application as a whole to describe messages sent using SMS.

Moreover, the application discloses text in a stream of SMS messages. FIG. 3, for example, shows a portion of such a stream. Person A initiates messages, sent as text stream 70, that contains at different times, text such as: “Hello” and “At Home,” which one of skill in the art would have understood to be a stream of SMS messages, with each message containing a portion of the text sent by Person A.

Accordingly, the rejection under 35 U.S.C. §112, first paragraph should be withdrawn.

Rejections Under 35 U.S.C. §103

The Office Action rejects claims 1-3, 5-7, 9 and 10 under 35 U.S.C. §103 based on Jong, Kredo and Marko.

Assignee respectfully disagrees with the characterization of Kredo in the Office Action. When the references are properly interpreted, there is no reason to combine bits and pieces of the multiple prior art references as asserted in the Office Action. Rather, components of the references have been combined based on hindsight gleaned from the disclosure of the present application.

In the Response to Arguments section, the Office Action interprets Kredo as describing alternative types of translations, such that only textual outputs may be outputted. However, the cited passage of Kredo (col. 7, lines 6-8) is not describing alternatives, but rather is describing that different inputs will be translated into different types of outputs, according to standard practice. The passage mentions that the outputs may be numbers, acronyms, icons or abbreviations. Contrary to the implication in the Office Action, the passage does not describe an alternative in which all inputs are translated to numbers and an alternative in which all inputs are translated to acronyms, and yet other alternatives in which all inputs are translated to icons or abbreviations, respectively. Rather, the passage should be fairly read as describing a system that translates text into a mix of numbers, acronyms, icons and abbreviations, with the mix depending on the specific content of the input text.

There are two reasons that, when Kredo is properly interpreted, the references are not properly combinable. First, the components of Jong and Kredo that are combined in making the rejection are not compatible and one of skill in the art would have had no reason to combine them. Second, the components of Kredo and Marko that are combined in making the rejection are not compatible and one of skill in the art would have had no reason to combine them. Because the rejection requires combining incompatible components, the rejection is not proper and must be withdrawn.

As described in the response filed 21 May 2009, the combination asserted in the Office Action includes a translator of Kredo, which has an output including graphical elements, coupled to a text to speech conversion system of Jong, which accepts only text as an input. The bits and pieces of Kredo and Jong that are combined according to the rejection are therefore not compatible because the combination involves graphical elements being input to a component that accepts only text as an input. Without hindsight reasoning based on the disclosure of the present application, one of skill in the art would have had no reason to combine these references.

The Office Action dismisses Assignee's arguments pointing out this incompatibility, asserting in the Response to Arguments that it is Jong that is relied upon as teaching production of synthesized speech using text. This response does not address Assignee's position. If Kredo is properly interpreted, it is clear that information, after processing as in Kredo, contains graphical elements and is not in a form that can be rendered by the synthesizer in Jong. Thus, the references are technically incompatible and are not properly combinable in the way asserted in the Office Action.

The Office Action offers as a further reason for dismissing Assignee's arguments that the features of Kredo and Jong used in the rejection are technically incompatible the teachings of Kredo. The Office Action points to a passage of Kredo (col. 8, lines 29-33) that describes text to speech conversion. Presumably, the Office Action implies that this passage of Kredo teaches that the output of the translator, including graphical elements, is converted to speech.

However, there is no indication in Kredo that the translation functions occur on the same messages that are rendered as speech. To the contrary, it appears that the translation functions of Kredo are performed on messages being sent from User A to User B and the text to speech is performed on messages sent in the opposite direction, from User B to User A. In Kredo, User A and User B are operating different types of devices so messages sent to and from User A and User B are treated differently. Thus, rather than providing support for the rejection, the cited passages at column 8 of Kredo emphasize that there is no teaching of Kredo of "converting the text message to an alternative text message," as claimed.

As a second reason that the references are not properly combinable as asserted in the Office Action, the translation system of Kredo produces an output that is incompatible with the compression function of Marko. Even if one can imagine an input that will produce an output that is only text, in general the output of the translator in Kredo will contain an unpredictable combination of numbers, acronyms, icons and abbreviations. As a result, the output of the translation of Kredo is not compatible with a system that accepts only text as an input.

The system of Marko is just such a system that would not be combined with Kredo. Marko describes a broadcast radio service and describes only text as an input for compression [0021]. For

this reason, it cannot be said that one of skill in the art would have had a reason to combine Kredo and Marko. Moreover, given the incompatibility, it cannot be said that one of skill in the art would have had a reasonable expectation of success from the combination. Accordingly, the references do not establish a *prima facie* case of obviousness.

Each of claims 2-3 and 5-10 depends, directly or indirectly, from claim 1 and should be allowed at least based on its dependency. Applicants do not necessarily concur with the interpretation of the defendant claims as set forth in the Office Action, nor do Applicants necessarily concur that the basis for rejection of any of the dependent claims is proper. However, Applicants believe that it is unnecessary to argue the allowability of each of the dependent claims individually. Therefore, Applicants reserve the right to specifically address the patentability of the dependent claims in the future, if deemed necessary.

Rejections Under 35 U.S.C. §103

The Office Action rejects claims 22 and 24 under 35 U.S.C. §103 based on Jong and Astrom. Assignee respectfully traverses the rejection. Independent claim 22 relates to operation of a mobile phone that includes sending speech in messages using SMS, which is not taught by any of the references.

The rejection is premised on only a partial quote of Jong. The partial quote changes the meaning of the cited passage. Though Jong mentions that subscriber terminals could be telephones, it does so only in the context of “telephones (wired or wireless) **connected to computing gateways with access to the Internet**” (col. 3, lines 1-3, emphasis added). Elsewhere, Jong describes that for a chat, the subscriber terminals each log onto their respective ISPs (col. 4, lines 57-59).

Accordingly, though Astrom indicates that mobile phones sometimes operate using SMS, it does not describe that phones as in Jong communicate using SMS. Specifically, there is no basis for the assertion that Astrom overcomes the express teaching of Jong of a phone connected to a computing gateway and logged onto an ISP.

Thus, Jong and Astrom, even if combined, do not teach using a mobile phone to transmit speech using SMS messages.

Claim 24 depends from claim 22 and should be allowed for at least the same reason. Claim 23 also depends from claim 22, and the rejection of claim 23 is premised on the combination of Jong and Astrom meeting all limitations of claim 22. In rejecting claim 23, the Office Action additionally cites Marko. However, Marko is not cited as curing the deficiencies of the combination of Jong and Astrom. Thus, claim 23 should also be allowed.

New Claims

New claims 25-26 relate to a method of use of a mobile phone that transmits speech as a stream of SMS messages. These claims are supported by the description throughout the application as filed, including at [0005] and the Title and as noted above in connection with the rejection under 35 U.S.C. §112. Moreover, claims 25-26 recite translation within a voice portal server. This limitation is supported, for example, by the depiction of voice portal (33) in FIG. 2, and the description in paragraphs [0011] and [0021].

Assignee respectfully submits that the combination of limitations in claims 25-26 is not met by the references of record. For reasons that should be apparent from the discussion of the references in connection with claim 22, above, the cited references do not meet limitations of claim 26, including: “transmitting from the mobile phone a stream of SMS messages directed to the second party, each SMS message comprising a portion of the text.”

Moreover, none of the references teaches: “within a voice portal server, for at least a portion of the SMS messages of the stream of SMS messages, translating the text of the SMS message before delivery to the second party.” For this additional reason, claims 25-26 distinguish over the art of record and should be allowed.

CONCLUSION

A Notice of Allowance is respectfully requested. The Examiner is requested to call the undersigned at the telephone number listed below if this communication does not place the case in condition for allowance.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, the Director is hereby authorized to charge any deficiency or credit any overpayment in the fees filed, asserted to be filed or which should have been filed herewith to our Deposit Account No. 23/2825, under Docket No. N0484.70557US00.

Dated:

Respectfully submitted,

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